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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/808,686 03/15/01 WATSON

J 21046-PA

EXAMINER

QM12/0727

LEONARD BLOOM & ASSOCIATES, LLC  
INTELLECTUAL PROPERTY LAW OFFICES  
401 WASHINGTON AVENUE, SUITE 905  
TOWSON MD 21204

DEXTER, C

ART UNIT

PAPER NUMBER

3724  
DATE MAILED:

5  
07/27/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/808,686

Applicant(s)

Watson

Examiner

Clark F. Dexter

Art Unit

3724



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-15 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other:

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6 and 14, drawn to a sawing device with a specific cutter configuration, classified in class 83, subclass 613.
  - II. Claims 1, 7, 11-13 and 15, drawn to a sawing device with a specific work holder configuration, classified in class 83, subclass 581.
  - III. Claims 1 and 8-10, drawn to a sawing device with a protector, classified in class 83, subclass 478.
2. Claims 1-13 have been restricted such that the patentability of the invention is presumed to lie in the details of the particular group (e.g. the specific cutter configuration of Group I). It is noted that if claim 1 as originally filed is part of an elected group and determined to be patentable, rejoinder of claims 1-13 will be considered. It is further noted that claim 1 is listed as part of groups I-III but is not considered to be part of any of these groups. Rather, claim 1 recites subject matter that is common to these groups and has been shown as part of each group for clarity (i.e., so that it is clear which claims are part of which group). Further, because claim 1 includes subject matter which is common to these groups, it is not considered to be independent or distinct from any of groups I-III and thus will be examined with the elected group upon election of one of these groups.

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3. The inventions are distinct, each from the other because of the following reasons:

4. Inventions of groups I and II are separate inventions. They are distinct because the invention of group I does not require the specific details of the work holder configuration (e.g., the channel-shaped work holding member) of group II for patentability as evidenced by the omission thereof from group I, and the invention of group II does not require the specific details of the cutter configuration (e.g., rod) of group I for patentability as evidenced by the omission thereof from group II.

5. Inventions of groups I and III are separate inventions. They are distinct because the invention of group I does not require the protector of group III for patentability as evidenced by the omission thereof from group I, and the invention of group III does not require the specific details of the cutter configuration (e.g., rod) of group I for patentability as evidenced by the omission thereof from group III.

6. Inventions of groups II and III are separate inventions. They are distinct because the invention of group II does not require the protector of group III for patentability as evidenced by the omission thereof from group II, and the invention of group III does not require the work holder configuration (e.g., the channel-shaped work holding member) of group II for patentability as evidenced by the omission thereof from group III.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and have acquired a separate

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status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

*Species*

8. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species IA - Figures 11-14;

Species IB - Figures 16-19.

Upon election of Group I, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.



**Clark F. Dexter**  
**Primary Examiner**  
**Art Unit 3724**

cfd  
July 26, 2001